

Application No.: 10/767,744

Docket No.: 713-1004

REMARKS

Applicant appreciates the Examiner's thorough review of the present application, and respectfully requests reconsideration in light of the preceding amendments and the following remarks.

Claims 19-24, 26-29, 31-36 and 38-41 are pending in the application. Claims 25, 30, 37 have been cancelled without prejudice or disclaimer. Claims 19-21, 24, 26, 28-29 and 33 have been amended to better define the claimed invention. New claims 39-41 have been added to provide Applicants with the scope of protection to which they are believed entitled. No new matter has been introduced through the foregoing amendments.

Applicant acknowledges the defect of the previously filed Terminal Disclaimer. A substitute Terminal Disclaimer is hereby submitted to obviate the double patenting rejection.

The 35 U.S.C. 103(a) rejection of claims 21-33 as being obvious over *Miura* is traversed for the reason advanced in the Amendment filed March 17, 2005, at pages 11-12 which is incorporated herein by reference. In particular, *Miura* teaches away from the one-piece structure of independent claim 21 and is not modifiable to arrive at the claimed invention, notwithstanding the Examiner's alleged "reduced manufacturing cost" argument. The Examiner is kindly asked to follow the USPTO guidance provided in *MPEP*, section 2145 in considering Applicant's rebuttal argument. (It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

As to claims 23-24, Applicant maintains the previously submitted position that the applied references, especially *Miura*, clearly fail to teach or suggest that the arm extends laterally away from said base portion and obliquely upwardly away from said resilient contact portion, whereby the recess and the elongated element held therein can be placed further from the support than said base portion, avoiding undesired contact and vibration transmission between the elongated element and the support. See claim 23. The Examiner's reliance on FIG. 30 of *Miura* for the claimed feature is noted. Applicant respectfully submits that arm 30 in FIG. 30 of *Miura* extends upwardly relative to substrate B, rather than contact portion 11b as presently claimed. This is, perhaps, due to off-center mounting of device 1 on support S. A person of ordinary skill in the

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art would recognize that FIGs. 29 and 30 of *Miura* show the same device 1. As can be seen in FIG. 29 of *Miura*, arm 30 does not extend upwardly relative to contact portion 11b as presently claimed, because arm 30 extends parallel to contact portion 11b. The rejection of claims 23-24 is therefore inappropriate and should be withdrawn.

As to claims 27 and 31, Applicant respectfully submits that the claimed **convex** lower surface is not an obvious designer's choice, because the claims feature is significant as disclosed in the specification, at the paragraph bridging pages 3-4. *See MPEP*, section 2144.04 IV. B.

As to claims 28-29, Applicant notes that the Examiner has not responded to Applicant's argument that the applied references, especially *Miura*, clearly fail to teach or suggest the claimed **annular downwardly extending wall positioned between said resilient contact elements** (because the *Miura* corresponding to element, i.e., the unnumbered, outermost element immediately above 11b in FIG. 30, is not positioned between the legs 11b). Clarification is respectfully requested.

As to claim 33, note the discussion *supra* with respect to claim 21.

The 35 U.S.C. 103(a) rejection of claims 19-20 and 34-38 as being obvious over *Miura* in view of *Thornton* (U.S. Patent Application Publication No. 2002/0100623) is traversed for the following reasons.

First, *Thornton* is non-analogous art that cannot be applied against the claims of the instant application in an obviousness rejection. "In order to rely on a reference as a basis for rejection of an applicant's invention [under 35 U.S.C. 103(a)], the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *See also In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). *See MPEP*, section 2141.01(a).

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Thornton relates to bicycle trailer (see Title) and, hence, is not in the field of Applicant's endeavor, i.e., retaining member for holding elongated elements on a support. *Thornton* deals with improvements on bicycle trailers and provision of extra power to bicycles. See *Thornton* at, e.g., paragraphs 0001 and 0019. Thus, the matter with which *Thornton* deals, logically would have not commended itself to an inventor's attention in considering the problem of vibration isolation. See, e.g., *Miura* at column 1, lines 38-47 and the instant application at page 1, the last paragraph. Accordingly, Applicant respectfully submits that *Thornton* is neither in the field of applicant's endeavor nor reasonably pertinent to the particular problem with which the inventor was concerned. *Thornton* is non-analogous art that cannot be used in a 35 U.S.C. 103(a) rejection against the claims of the instant application.

Second, the Examiner's rationale found in the Office Action at page 5, the first full paragraph lacks an adequate suggestion or motivation to connect the *Thornton* lining 26 with the *Miura* contact portion 11b. Clarification is respectfully requested.

Third, if it is the Examiner position that it would also have been obvious to connect the *Thornton* lining 26 with the *Miura* contact portion 11b as presently claimed, Applicant respectfully submits that such combination would render the device being modified, i.e., *Miura*, unsatisfactory for its intended purpose of allowing easy replacement of parts. See, e.g., column 7, lines 35-45 of *Miura*. In fact, when *Miura* is modified in the Examiner's proposed manner, lining 29a (FIG. 1 of *Miura*) would be connected to legs 11b and preclude disassembly of attaching part 2 from clamp body 21.

Accordingly, Applicant respectfully submits the obviousness rejection of claims 19-20 and 34-38 is inappropriate and should be withdrawn.

New claims 39-41 depend from claim 38, and are considered patentable at least for the reason advanced with respect to claim 38. Claims 39-41 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art, as will be apparent to the Examiner upon reviewing these claims.

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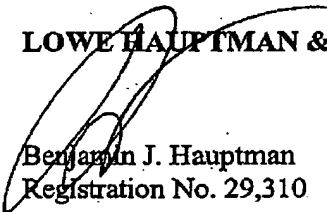
Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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